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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,918	12/16/2003	Jeffrey H. Hoel	07844-255002 / P229 C1	8364
21876	7590	08/18/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/738,918	<b>Applicant(s)</b> HOEL, JEFFREY H.	
	<b>Examiner</b> Thomas D. Lee	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 33-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/16/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is responsive to applicant's preliminary amendment filed December 16, 2003. Claims 33-46 are pending.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 43 (which includes all of the limitations of base claim 34) is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of prior U.S. Patent

No. 6,741,368. This is a double patenting rejection.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

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are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 33-42 and 44-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-26 of U.S. Patent No. 6,741,368. Although the conflicting claims are not identical, they are not patentably distinct from each other because each limitation recited in the application claims reads directly on a corresponding limitation in the patent claims.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 33-35, 37, 41, 42 and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,710,719 (Houle).

Regarding claim 33, Houle discloses a method of compressing a two-dimensional image (note title of patent), the two-dimensional image divided into a sequence of scan lines where each scan line includes a sequence of pixels and where each pixel has an associated value representative of a shade to be rendered when displaying the two-dimensional image on a raster output device (image data formed by pixel array (read Abstract), displayed by display 20 (Fig. 1)), the method comprising: processing pixels in raster order (column 11, lines 46-51) including, for each pixel, comparing the value of the pixel with values of a plurality of previously processed pixels (column 10, lines 12-18), and if a match is detected then encoding the pixel as a reference to a matching pixel and a length where the length is determined based on a number of consecutive pixels that satisfy a matching criterion where the matching criterion is defined by a relationship between the pixel and the matching pixel (column 10, lines 19-65; column 14, lines 49-67); and if the value of the pixel does not match the value of any of the plurality of previously processed pixels then encoding the pixel value (compare pixel string and encoded string at column 14, lines 60 and 67, respectively).

Regarding claims 34, 35, 37, 41, 42, 44 and 45, Houle discloses a method of generating a compressed representation of a two-dimensional image where the image is described as a sequence of pixels in raster order, the method comprising: receiving the two-dimensional image as a sequence of pixels in raster order (column 7, lines 18-36); for each pixel, determining whether the pixel is part of a first string of pixels that is identical to a second string of pixels found previously in the image at one of a plurality of preselected fixed distances from the first string of pixels (column 8, lines 31-49; column

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10, lines 19-49); if so, encoding the first string of pixels as a string token that is a reference to the second string of pixels; otherwise, encoding the pixel as a non-string token (column 14, lines 49-67). One of the preselected fixed distances is one pixel, thereby allowing the first string of pixels to be encoded as a reference to the second string of pixels that occurred one pixel earlier in the two-dimensional image (number "1" directly above target pixel "#" (column 8, lines 39-43) represents a preselected fixed distance (pixel offset) of one pixel from the target pixel). The preselected fixed distances are two in number (number "2" represents a second fixed distance from the target pixel). The string token is encoded by encoding the preselected fixed distance from the first string of pixels to the matching second string of pixels and a length of the first string of pixels (column 14, lines 52-56). The string token or non-string token is encoded based on one or more previously encoded tokens preceding the string token or non-string token (column 14, lines 56-67). The step of encoding the first string of pixels as a reference to the second string of pixels includes dividing tokens into groups and encoding a token by encoding its group and encoding the particular token within a given group with a code (note sequence at column 14, line 67). The token within a group code can be variable length (column 15, lines 8-21).

Regarding claim 46, Houle discloses a method of generating a compressed representation of a two-dimensional image as a sequence of encoded tokens, each token representing either a first string of pixels that is identical to a second string of pixels that occurs previously in the image as a sequence of pixels in raster order, comprising: receiving the sequence of pixels (column 7, lines 18-36); for each pixel,

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determining whether the pixel is part of a first string of pixels that is identical to a second string of pixels found previously in the image at one of a plurality of preselected fixed distances from the first string of pixels (column 8, lines 31-49; column 10, lines 19-49); if so, encoding the pixel in the first string of pixels; otherwise, encoding the pixel (column 14, lines 49-67).

***Allowable Subject Matter***

9. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to disclose or suggest applicant's method of base claim 34, "where one or the preselected fixed distances is a length of one scan line of the two-dimensional image, thereby allowing the first string of pixels to be encoded as a reference to the second string of pixels that occurred directly above the first string of pixels on an immediately previous scan line," as recited in claim 36, or "where one of the preselected fixed distances is one plus a length of one scan line of the image, thereby allowing the first string of pixels to be encoded as a reference to the second string of pixels that occurred on an immediately previous scan line, one pixel to the left of the first string of pixels," as recited in claim 38, or "where the preselected fixed distances are fewer in number than the maximum fixed distance," as recited in claim 39, or "where a length of the first string of pixels is unbounded," as recited in claim 40, or "further including encoding a single pixel as a ranking based on a distance of its value from a value of a previous pixel," as recited in claim 43.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-

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7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thomas D Lee  
Primary Examiner  
Technology Division 2625

tdl  
August 16, 2006